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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/617,063 | 07/10/2003 | Clayton T. Bauer | 10221-001 | 2643 |
| 29391 | 7590 | 11/10/2004 | EXAMINER | |
| BEUSSE BROWNLEE WOLTER MORA & MAIRE, P. A. | | | REIMERS, ANNETTE R | |
| 390 NORTH ORANGE AVENUE | | | ART UNIT | |
| SUITE 2500 | | | PAPER NUMBER | |
| ORLANDO, FL 32801 | | | 3732 | |

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/617,063 | BAUER, CLAYTON T. | |
| | Examiner | Art Unit | |
| | Annette R. Reimers | 3732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/17/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3-7, 10, 11, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which the applicant regards as the invention.

In claim 3, line 4, "the convex surface " lacks proper antecedent basis.

In claim 5, line 2, "the adjustment rod" lacks proper antecedent basis.

In claims 10 and 11, line 1 of both claims, "the convex cutting surface" lacks proper antecedent basis. Furthermore, it appears as though claims 10 and 11 should depend from claim 9 instead of claim 1 in order to provide proper antecedent basis for "the convex cutting surface".

In claim 14, line 19, "the desired cutting arc" lacks proper antecedent basis.

In claim 16, lines 2 and 3, respectively, "the convex surfaces" and "the desired cutting arc" lack proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 9, 10, 12, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Fishbein (US Patent No. 3,702,611), cited by applicant.

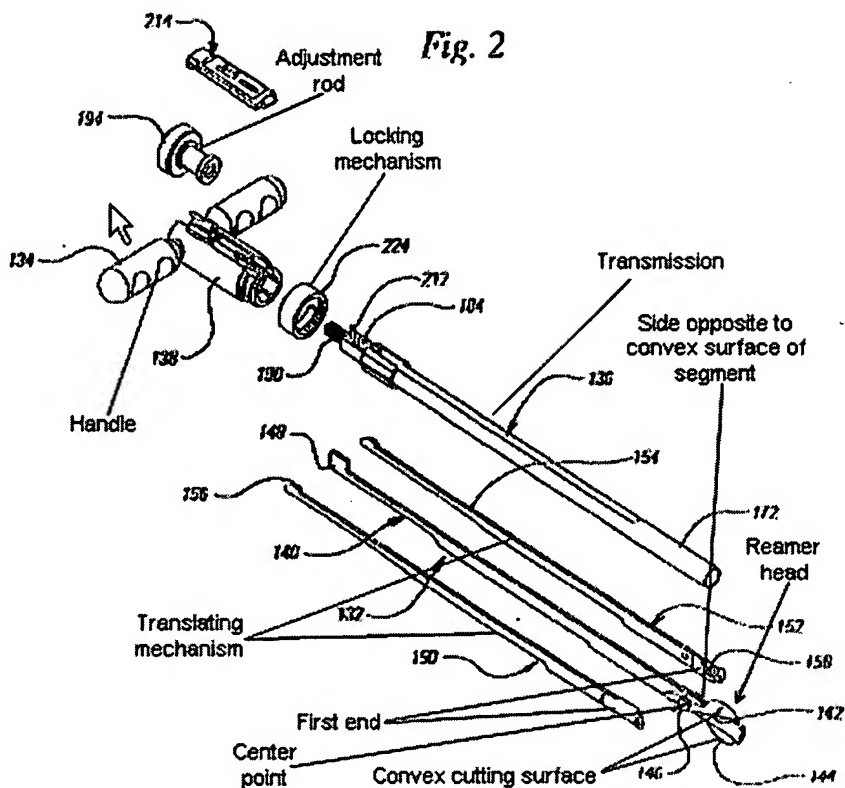
Fishbein discloses a reamer comprising a reaming head, e.g. part 22, comprising a plurality of arcuately-shaped segments, each comprising a convex cutting surface with a cupped configuration, (see Figure 3), and the plurality of segments are generally symmetrically distributed about a center point, i.e. the longitudinal axis of the reamer (see Figure 5), and are extendable and retractable about the center point (see Figure 3). In addition, the reamer device of Fishbein comprises an actuator, e.g. parts 24 and 25 of Figures 3 and 3a. The reamer further comprises a drive shaft, e.g. part 20, having a driving end, e.g. part 23, and a driven end, e.g. part 21. The reaming head is attached to the driving end (see Figures 1 and 2, see also column 3 lines 4-6). In addition, the driven end is adapted to receive a rotational device (see column 3 lines 2-3). The Fishbein device further comprises a freely spinning sleeve, e.g. part 42', slidably positioned over the drive shaft.

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Claims 1-3, 5, 6, 9-11, 15, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuslich et al. (US Patent No. 6,383,188), cited by applicant.

Kuslich discloses a reamer comprising a reaming head (see Figure 2 below) comprising a plurality of arcuately shaped segments, i.e. convex cutting surfaces, e.g. parts 142 and 144 of Figure 2 below. In addition, the convex cutting surface could have a cupped configuration (see Figures 5 and 6) or a grating hole configuration (see Figures 14-17). The plurality of segments are generally symmetrically distributed about a center point, e.g. part 146 of Figure 2 below, and are extendable or retractable about the center point (see Figure 6).

Also, in Kuslich, the reamer comprises an actuator (see Figure 2 below) comprising a plurality of translating mechanisms, e.g. parts 150 and 152 of Figure 2 below, each mechanism having a first end and second end (see Figure 2 below), the first end is attached to a respective segment on a side opposite the convex surface of the segment (see Figure 2 below), each translating mechanism providing translational movement of the respective segment (see Figures 8 and 9). Furthermore, the Kuslich device has a transmission mechanically coupled to each of the translating mechanisms at the second end (see Figure 2 below) and an adjustment rod, e.g. part 194 of Figure 2 below.



The actuator further comprises an adjustment handle, e.g. part 134 of Figure 2 above, coupled to an adjustment rod (see also Figure 3). Moreover, the adjustment handle comprises a locking mechanism, e.g. part 224 of Figure 2 above, (see also column 3 lines 27-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuslich et al. (US Patent No. 6,383,188), cited by applicant.

Kuslich et al. disclose the claimed invention except for the incremental translation distances being 1 millimeter (0.04 inch) increments (claim 7) and/or the plurality of segments forming an arc subtending an angle of approximately 180 degrees about the center point (claim 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the reamer device of Kuslich with incremental translation distances of 1 millimeter (0.04 inch) increments and/or with the plurality of segments forming an arc subtending an angle of approximately 180 degrees about the center point, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 8 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Fishbein (US Patent No. 3,702,611), cited by applicant.

Fishbein discloses the claimed invention except for the plurality of segments forming an arc subtending an angle of approximately 180 degrees about the center point (claim 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the reamer device of Fishbein with the plurality of segments forming an arc subtending an angle of approximately 180 degrees about the center point, since it has been held that where the general conditions of a

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claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached Monday-Friday, 8:30am-6:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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EDUARDO C. ROBERT
PRIMARY EXAMINER